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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,955	10/24/2001	Trevor Harms	051373-0115	8428

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EXAMINER
BLENMAN, AVALON

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		10/039,955	HARMS ET AL.
		Examiner	Art Unit
		Avalon Blenman	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 August 2005_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-21_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-21_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This office action is a <u>second action</u> in response to amendment and remarks filed

August 22nd, 2005. Claims 1-21 are presented for further consideration, of which 1, 12,

& 21 are independent claims. Claims 12, 19, & 20 have been amended. No claims

have been cancelled or added. This office action is made **FINAL**.

Response to Amendment

2.   The amendments to claims 12, 19, and 21 have been entered. The objection to

claims 12 & 19 in previous Office Action dated 02/23/2005 have been withdrawn.

Specification

3.   The disclosure is objected to because it contains an embedded hyperlink and/or

other form of browser-executable code (pg. 2, line 5). Applicant is required to delete the

embedded hyperlink and/or other form of browser-executable code. See MPEP §

608.01.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims **1-2, 4-8, 11-13, & 15-21** are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Hara et al. (US Patent 5,938,725)**, hereinafter Hara, further in view

of **Haynes et al. (US Patent 6,442,591)**, hereinafter Haynes, and further in view of

Creswell et al. (US Patent 6,564,264), hereinafter Creswell.

6.   In referencing to independent claims **1 & 21**, Hara discloses a method of (fig. 2)

and system (fig. 1) for:

-   extracting (fig. 2, step S3) contact information (electronic mail address) from a

    number of messages stored in a memory (fig. 1, #10, storage apparatus) in a

    device (electronic mail transmitting/receiving device) [col. 5, lines 53-55, col. 6,

    lines 54-58, 64-67]; and

Hara does not explicitly disclose that the extracted contact information is entered

into a contact list. Nonetheless, in analogous art, Haynes discloses a method (fig 4) of,

and system for (fig. 1) for populating a contact list on a device by extracting (stripping)

contact information from incoming messages (col. 4, lines 31-33). Haynes further

discloses:

-   entering (storing) the extracted (stripped) contact information (electronic mail

    address) into a contact list (fig. 2, #24, retrieved contact list) maintained by a

    program operating on the device [fig. 4, steps 44 & 52, col. 4, lines 31-53].

Given the teachings of Haynes, at the time of the invention, it would have been

obvious to one of ordinary skill in the art to modify the system/method disclosed by Hara

where the extracted contact information would be entered into a contact list. The

motivation, as suggested by Hayes, would be so that the extracted contact information

is conveniently accessible at any time to the user [col. 4, line 48-53].

Both Hara and Haynes are silent as to if their devices are portable devices.

Nonetheless, in analogous art, Croswell discloses a method (fig. 2, step 201, 203, 215,

& 217) of populating a contact list (fig. 1, #30, user's address book) by extracting

contact information (address) from [returned] messages [col. 4, lines 4-7, 30-36].

Croswell further discloses a portable device (fig. 1, #15, wireless handset) for retrieving

and transmitting e-mail messages [col. 3, lines 23-32].

Given the teachings of Croswell, at the time of the invention, it would have been

obvious to one of ordinary skill in the art to modify the system/method disclosed by Hara

in view of Haynes where the messages would stored in memory on a portable device

and the extracted contact information would be maintained by the portable device. This

would have been a desirable feature, because the user could access the extracted

contact information via the portable device which will most likely accompany the user at

all time, where the user can avoid having to travel back to the office for example to

retrieve the contact extracted contact information from a stationary apparatus.

7.   In referencing to claims **2 & 17**, Hara discloses:

- monitoring incoming messages (fig. 2, #10, receive electronic mail messages) and retrieving (fig. 2, step S3) contact information (electronic mail addresses) from incoming messages [col. 6, lines 64-67].

8.   In referencing to claims **4 & 18**, Hara discloses extracting contact information includes:

- scanning ("sequentially reading", col. 6, lines 54-56) a message database (fig. 1, #10, storage apparatus) and retrieving (extracting) contact information (electronic mail address) from messages contained in the database [col. 6, lines 64-67].

9.   In referencing claim **5** Hara discloses:

- the scanning ("sequentially reading") occurs since a certain time ["since the user inputs a key word", fig. 2, step S1, col. 6, lines 49-58].

10.   In considering claim **6**, Hara inherently discloses:

- The certain time is the time of the last scanning ["since the user inputs a key word", fig. 2, step S1, col. 6, lines 49-58].
  [The scanning takes place every time the user inputs a keyword to be searched (fig. 2, step S1). It is therefore inherent that the next scan will take place when the user enters the next keyword to be searched (after the last/previous scan)].

11.   In referencing to claims **7 & 19**, Hara discloses:

- providing a graphical user interface (GUI) (fig. 1, # 13, output apparatus) with

    contact information (electronic mail address) configured to receive a selection

    from a user of the device (fig. 2, #14, selection apparatus) [col. 6, lines 27-37].

12.   In referencing to claims **8, 15, & 20**, Hara in view of Haynes do not explicitly

disclose only entering contact information not already contained in the contact list.

Nonetheless, Croswell discloses:

- automatically entering in the contact list only contact information not already

    contained in the contact list [fig. 2, steps 215-217, col. 4, lines 30-36, col. 5, lines

    18-20].

13.   In referencing to claim **11**, Hara discloses:

- filtering contact information to include in the contact list only email sender

    information [fig. 2, "sender: address 5", col. 4, lines 2-11, col. 6, lines 9-17].

14.   In referencing to independent claim **12**, Hara discloses a user interface (fig. 1,

#13, output apparatus, col. 6, lines 22-26). Hara further discloses:

- means for extracting contact information (electronic email address) from a

    number of messages stored in a memory in a device [fig. 2, stepS3, col. 5, lines

    53-55, col. 6, lines 54-58, 64-67;

- means for presenting the extracted contact information (electronic mail address)

    on a device [fig. 1, #13, output apparatus, col. 6, lines 27-30];

Haynes discloses:

- means for receiving (fig. 4, step 44) a number of selections of contact to be stored in the contact list [col. 4, lines 31-53]; and

- means for entering (fig. 4, step 52) the selected contact information into a contact list (fig. 2, #24, retrieved contact list) maintained by a program operating on the device col. 4, lines 31-53].

Although Hara in view of Haynes teach all of these features, neither explicitly disclose a portable device. Nonetheless, as set forth above in reference to claim 1, Creswell discloses a portable device [fig. 1, #15, wireless handset, col. 3, lines 23-32] fore retrieving electronic messages.

15.   In referencing to claim **13**, Hara implicitly discloses

- providing a checklist of extracted contact information (electronic mail address) [col. 4, lines 2-11, col. 6, lines 33-37].

  [If the user is presented with extracted contact information, in the form of a list (plurality of transmission destination candidates) and the user is able to select from the list of candidates, it implicitly a checklist]

16.   In referencing to claim **16**, Hara discloses a processing system (fig. 1) comprising:

- a central processing unit (CPU) [fig. 1, #12, col. 5, lines 47-52];

- a storage device coupled to a processor stored there information for configuring
  a CPU to [inherent feature of any computer, fig. 1, #12, col. 5, lines 47-52]:

- extract (fig. 2, step S3) contact information (electronic mail address) from a
  number of messages stored in a memory (fig. 1, # 10, storage apparatus) in a
  device [col. 5, lines 53-55, col. 6, lines 54-58, 64-67].

Haynes discloses a CPU configured to:

- enter (store) the extracted (stripped/retrieved) contact information (electronic mail
  address) into a contact list (fig. 2, #24, retrieved contact list) maintained by a
  program operating on a device [col. 4, lines 47-53].

Although Hara in view of Haynes teach all of these features, neither explicitly disclose a portable device. Nonetheless, as set forth above in reference to claim 1, Creswell discloses a portable device [fig. 1, #15, wireless handset, col. 3, lines 23-32] for retrieving electronic messages.

17.   Claims **3, 9, 10 &14** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hara** in view of **Haynes** and **Creswell** as applied to claim 1above, and further in view of **Checkoway et al. (US Publication 2002/0133554)**, hereafter referred to as Checkoway.

18.   In referencing to claim **3**, Hara in view of Haynes and Creswell do not explicitly

disclose an extracted Simple Mail Transfer Protocol (SMTP) email address.

Nonetheless, in analogous art, Checkoway discloses a method of (step 572) of and

system for (fig. 1) extracting contact information (sender e-mail) from incoming

messages (¶9, ¶26). Checkoway further implicitly discloses that communication is via

SMTP e-mail.

- contact information (sender email) includes a simple mail transfer protocol
  (SMTP) [fig. 2, #204, ¶19].

Given the teachings of Checkoway, at the time of the invention, it would have

been obvious to one of ordinary skill in the art to modify the system/method disclosed by

Hara in view of Haynes and Croswell, where the contact information extracted from the

message would include a SMTP email address. The motivation, as suggested by

Checkoway would be so that stored messages can later be retrieved using a Post Office

Protocol (POP) and the email address extracted [¶17, ¶19, & ¶24].

19.   In referencing claims **9 & 10**, Hara, in view of Haynes and Creswell do no

explicitly teach filtering contact information to be included/excluded from a contact list

according to a domain. Nonetheless, Checkoway discloses

- filtering contact information to include or exclude contact information from emails
  received from certain domains ["@halibot.com", ¶52]

- filtering contact information to include or exclude contact information from

  received addresses from certain domains ["@halibot.com", ¶52]

20.   In referencing to claim **14**, Hara in view of Haynes and Creswell do not explicitly

teach that his wireless handset is a Wireless Application Protocol (WAP) phone.

Nonetheless, Checkoway discloses a means for presenting extracted information in the

form of a WAP response [¶19].

Response to Arguments

21.   Applicant's arguments filed August 22nd, 2005 have been fully considered but

they are not persuasive.

22.   Regarding in dependent claims 1, 12, & 21, Applicant argues (pg. 8) that a user

of Hara's system is not concerned with automatically updating an address book or the

accessibility of the address book. Examiner agrees. Hara's system automatically

extracts the contact information from retrieved/incoming e-mail messages and presents

this contact information to the user for selection (col. 6, lines 18-37). Hara does not

explicitly disclose entering the contact information into a contact list. Nonetheless as

set forth above in reference to claim 1, storing of the extracted contact information into a

contact list maintained on the device is taught in analogous art by Haynes [fig. 4, steps

44 & 52, col. 4, lines 31-53]. Haynes indeed teaches accessing an electronic address

book and populating a contact list [fig. 4, steps 44 & 52, col. 4, lines 31-53. While Hara

in view of Haynes teach substantial features of independent claims 1, 12, & 21, Hara in

view of Haynes do not explicitly disclose a portable device. Nonetheless as set forth

above in reference to claim 1, Creswell teaches a portable device for receiving

electronic messages [col. 3, lines 23-32].

23.   Examiner maintains that Hara, in view of Haynes, and further in view of Creswell

read on the limitations as claims and argues, and thus maintains the present rejections.

Conclusion

24.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

25.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Avalon Blenman whose telephone number is (571) 272-
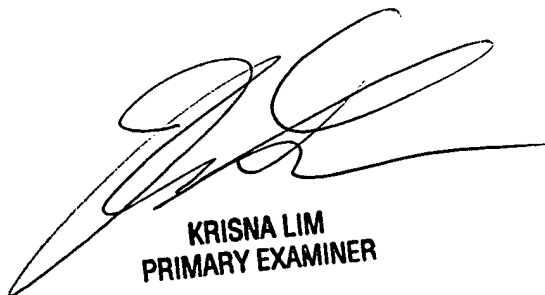
5864. The examiner can normally be reached on Mon-Fri, 7:00 AM - 4:30 PM (even

date Mons. off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Avalon Blenman
December 3rd, 2006

KRISNA LIM
PRIMARY EXAMINER